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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,860	03/12/2002	Andrei Gonioukh	50734	2595

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EXAMINER
WRIGHT, SONYA N

ART UNIT	PAPER NUMBER
1626	

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/070,860	GONIOUKH ET AL.	
	Examiner	Art Unit	
	Sonya Wright	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 and 24-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☒ Claim(s) 21-23 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>0803</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 15-28 are pending in this application.

Election/Restrictions

Applicant's election with traverse of Group IV in the communication filed July 3, 2003 is acknowledged. The traversal is on the ground(s) that regarding the present claims, "as the technical interrelationship and the same or corresponding special technical features are present, this group of inventions [is] so linked as to form a single general inventive concept. . .[as] there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features". Additionally, Applicants specifically request that at least the claims of Group V be rejoined.

However, the process of claim 23 is drawn to a process for preparing compounds of formula (VI), and the process of Group V is drawn to a process for preparing polyolefins. The process of claim 23 and the process of Group V have different reactive steps and different products. Therefore, Group V is patentably distinct from Group IV, and Group V has not been rejoined.

Furthermore, the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain the following common core:



which does not define a contribution over the prior art. The core (supra) contains variables variables R1, R2, R3, R4, R5, and R6, etc. . . which are divergent, and when

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taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking a restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Additionally, the vastness of the claimed subject matter and the complications in understanding the claimed subject matter imposes a burden on any examination of the claimed subject matter.

The following generic concept as depicted in claim 15 is identified for examination along with the elected embodiment: R1, is a radical of the formula NR₅R₆ wherein R₅ and R₆ together with the N atom form a 5-, 6-, or 7-membered ring which may be saturated or unsaturated and unsubstituted, substituted or fused with further carbocyclic 5- or 6-membered rings which may in turn be saturated or unsaturated or substituted or unsubstituted; R2 is a radical of the formula NR₅R₆ wherein R₅ and R₆ together with the N atom form a 5-, 6-, or 7-membered ring which may be saturated or unsaturated and unsubstituted, substituted or fused with further carbocyclic 5- or 6-membered rings which may in turn be saturated or unsaturated, substituted or unsubstituted; and R3, R4, M, X, and n are as defined. The remaining subject matter of claims 21-23 in part and claims 15-20 and 24-28 in their entirety stands withdrawn from further consideration under 37 CFR 1.142(b) as constituting other patentably distinct inventions.

The withdrawn subject matter of claims 21-23 in part and claims 15-20 and 24-28 in their entirety is properly restricted as said subject matter differs in structure and element from the elected subject matter so as to be patentably distinct therefrom, i.e. a

reference which anticipated the elected subject matter would not even render obvious the withdrawn subject matter and fields of search are not co-extensive.

Claims 21-23 are objected to as containing non-elected subject matter. This objection may be overcome by limiting the claims to the elected subject matter identified *supra*.

Specification

The specification is objected to for the following reason: The specification lacks a statement acknowledging continuing data.

It is requested that Applicant insert a statement at the beginning of the specification acknowledging the continuing data in this application.

The references on the PTO-1449 that the Examiner did not have copies of have been lined through.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Wright, whose telephone number is (703) 308-4539. The examiner can normally be reached on Monday-Friday from 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7922. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for

draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.



Joseph K. McKane

Supervisory Patent Examiner

Group 1600

Sonya Wright

August 4, 2003